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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF: Hidenori NAKAJIMA, et al.

SERIAL NO.: NEW U.S. PCT APPLICATION

FILED: HEREWITH

INTERNATIONAL APPLICATION NO.: PCT/JP03/05431

INTERNATIONAL FILING DATE: April 28, 2003

FOR: NOVEL 35 KD PROTEIN

**REQUEST FOR CONSIDERATION OF DOCUMENTS  
CITED IN INTERNATIONAL SEARCH REPORT**

Commissioner for Patents

Alexandria, Virginia 22313

Sir:

In the matter of the above-identified application for patent, notice is hereby given that applicant(s) request that the Examiner consider the documents cited in the International Search Report according to MPEP §609 and so indicate by a statement in the first Office Action that the information has been considered. When the Form PCT/DO/EO/903 indicates both the search report and copies of the documents are present in the national stage file, there is no requirement for the applicant(s) to submit them (1156 O.G. 91 November 23, 1993).

Respectfully submitted,

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## INTERNATIONAL SEARCH REPORT

International application No.

PCT/JP03/05431

## A. CLASSIFICATION OF SUBJECT MATTER

Int.Cl<sup>7</sup> C12N15/12, C07K14/435, C07K16/18, C12Q1/02, C12Q1/68,  
G01N33/53, G01N33/15, A61K38/00

According to International Patent Classification (IPC) or to both national classification and IPC

## B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

Int.Cl<sup>7</sup> C12N15/12, C07K14/435, C07K16/18, C12Q1/02, C12Q1/68,  
G01N33/53, G01N33/15, A61K38/00

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)

REGISTRY/CA/BIOSIS/WPIDS/MEDLINE (STN),  
Genbank/EMBL/DDBJ/GeneSeq, SwissProt/PIR/GeneSeq

## C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category*	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	WO 99/61645 A1 (FUJISAWA PHARM CO., LTD.), 02 December, 1999 (02.12.99), & JP 2002-510335 A	1-11, 13, 14, 17-19
A	Kawai J. et al., Functional annotation of a full-length mouse cDNA collection., Nature, (2001), Vol. 409, No. 6821, pages 685 to 690	1-11, 13, 14, 17-19
P, A	WO 02/46385 A2 (INCYTE GENOMICS INC.), 13 June, 2002 (13.06.02), & AU 200236595 A	1-11, 13, 14, 17-19
P, A	Strausberg RL et al., Generation and initial analysis of more than 15,000 full-length human and mouse cDNA sequences., Proc.Natl.Acad.Sci. U.S.A., (2002 December), Vol.99, No.26, pages 16899 to 16903	1-11, 13, 14, 17-19

 Further documents are listed in the continuation of Box C. See patent family annex.

- \* Special categories of cited documents:  
 "A" document defining the general state of the art which is not considered to be of particular relevance  
 "E" earlier document but published on or after the international filing date  
 "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)  
 "O" document referring to an oral disclosure, use, exhibition or other means  
 "P" document published prior to the international filing date but later than the priority date claimed

- "T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention  
 "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone  
 "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art  
 "&" document member of the same patent family

Date of the actual completion of the international search  
17 July, 2003 (17.07.03)

Date of mailing of the international search report  
05 August, 2003 (05.08.03)

Name and mailing address of the ISA/  
Japanese Patent Office

Authorized officer

Facsimile No.

Telephone No.

# INTERNATIONAL SEARCH REPORT

International application No.

PCT/JP03/05431

## Box I Observations where certain claims were found unsearchable (Continuation of item 2 of first sheet)

This international search report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1.  Claims Nos.:

because they relate to subject matter not required to be searched by this Authority, namely:

2.  Claims Nos.: 12, 15, 16

because they relate to parts of the international application that do not comply with the prescribed requirements to such an extent that no meaningful international search can be carried out, specifically:

Concerning the "compounds" as set forth in claims 12, 15 and 16, the description merely states that compounds A and B bind to a 35 kd protein but declares nothing what compounds correspond thereto and thus the compounds are not restricted to any specific compound(s) (continued to extra sheet)

Claims Nos.:

because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

## Box II Observations where unity of invention is lacking (Continuation of item 3 of first sheet)

This International Searching Authority found multiple inventions in this international application, as follows:

1.  As all required additional search fees were timely paid by the applicant, this international search report covers all searchable claims.
2.  As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee.
3.  As only some of the required additional search fees were timely paid by the applicant, this international search report covers only those claims for which fees were paid, specifically claims Nos.:
4.  No required additional search fees were timely paid by the applicant. Consequently, this international search report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

Remark on Protest

The additional search fees were accompanied by the applicant's protest.

No protest accompanied the payment of additional search fees.

**INTERNATIONAL SEARCH REPORT**

International application No.

PCT/JP03/05431

Continuation of Box No.I-2 of continuation of first sheet(1)

therein. Such being the case, it is completely unclear what specific compounds are involved in the scope of the "compounds" according to claims 12, 15 and 16 and what are not. Namely, claims 12, 15 and 16 are described in an extremely unclear manner.